UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD S. STEELMAN and JOHN R. DAVIS

Appeal No. 2005-0984
Application No. 09/479,648

ON BRIEF

Before PAK, KRATZ and JEFFERY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 29-31, 34-36, 38-40 and 57-61, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a adhesive film application method, a method of saving labor using such an application process and a kit useful for applying films to a substrate. An understanding of the invention can be derived from a reading of exemplary claims 30 and 34, which are reproduced below.

30. A kit for application of films to a substrate, comprising:
a) a Heat Neutral Pressure Source, and
b) a heat source adapted for applying heat to an adhesive coated film during application to a substrate.

34. A method of applying an adhesive-coated film to a substrate, the method comprising:
providing a film comprising pressure sensitive adhesive coated on a major surface of the film;
heating the film to the softening point of the film; and
pressing the film against a substrate with a Heat Neutral Pressure Source after heating the film, wherein the pressure sensitive adhesive on the major surface of the film adheres to the substrate.

In addition to allegedly admitted prior art, the prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Coe	754,403	Mar. 08, 1904
Sadtler	1,672,093	Jun. 05, 1928
Moore	1,895,045	Jan. 24, 1933
Werstlein	3,853,669	Dec. 10, 1974
Preisler	3,861,988	Jan. 21, 1988
Alfter et al. (Alfter)	3,962,016	Jun. 08, 1976
Finke	4,261,783	Apr. 14, 1981
Boyd et al. (Boyd)	4,511,425	Apr. 16, 1985
Peacock et al. (Peacock)	5,800,919	Sep. 01, 1998

Claims 29-31, 34-36, 38-40 and 57-61 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as invention. Claims 29-31, 34-36, 40, 57-59 and 61 stand rejected under 35 U.S.C. § 102 as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock. Claims 38 and 57-61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock, each in view of Preisler and/or Coe and/or Sadtler. Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock, each in view of Moore and/or Finke. Claim 30 stands rejected under 35 U.S.C. § 102 as being anticipated by Alfter, Boyd or Werstlein.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

We reverse the § 112, second paragraph rejection because the examiner has not established that arguments of counsel in an earlier reply (response) to an office action are presently germane to, let alone result in, a prima facie case of indefiniteness of the claims on appeal before us based on an asserted ambiguity introduced by argument presented in that earlier reply to an office action. However, we find that the appealed claims are in violation of the requirements of the second paragraph of 35 U.S.C. § 112 for reasons substantially different from those stated by the examiner in the answer. Accordingly, pursuant to 37 CFR § 41.50(b)(2002), we enter a new ground of rejection under § 112, second paragraph of all of the appealed claims because no reasonably definite meaning can be ascribed to certain language appearing in the claims for reasons set forth below in the new ground of rejection.

Moreover, in comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculation and assumptions are necessary in order to determine what in fact is being claimed.[1] Since a rejection based on prior

[1] As the court in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

art cannot be based on speculation and assumptions, see In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, pro forma, the examiner's rejections of the appealed claims under 35 U.S.C. § 102 and 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of those prior art rejections.

New Ground of Rejection

Pursuant to 37 CFR § 41.50(b), we enter the following new rejection.

Claims 1-3, 7-14 and 17-29 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

A contested matter common to all of the appealed claims is the correct interpretation to be assigned to the claim term "Heat Neutral Pressure Source." During prosecution of a patent application, the claims therein are given the broadest reasonable interpretation consistent with the specification. Gechter v.

> [a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

As pointed out by appellants at page 9 of the brief, appellants' specification provides a definition for that contested claim term at page 5, lines 17-21 wherein it is stated that:

> [f]or purposes of this invention, a "Heat Neutral Pressure Source" is a pressure source that has thermal conductivity characteristics and surface characteristics at the point of contact with the film such that the film, when nearly melted, will not adhere to the Heat Neutral Pressure Source during application in accordance with the method of the present invention to a surface.

As evident by a review of that reproduced definition, appellants furnish a functional definition for the thermal conductivity and surface characteristics of the Heat Neutral Pressure Source that in part relies on a term of degree, "nearly melted" and in part relies on the general meaning of the omnibus phrase "during application in accordance with the method of the present invention," without providing guidelines as to how to measure that term of degree "nearly" and further explaining what process modifications would be encompassed by the phrase - a process according to the present invention -, and what process

modifications would not be so encompassed. After all, a principal purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Moreover, when a word of degree is used, such as the term "nearly" as employed by appellants in the contested claim term definition, it is necessary for the specification to also provide a standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984). Here, appellants' specification does not furnish a standard for measuring the closeness to the melting point that is required by the term "nearly " so that a reasonable assessment can be made of the thermal conductivity and surface characteristics required by the contested claim term, "Heat Neutral Pressure Source."

In this regard, we additionally note that appellants have furnished an additional test at page 6, lines 8-16 of their

specification for determining when a material may not be suitable for use as a Heat Neutral Pressure Source for a particular film. However, the result of that test would not only be dependent on the particular film (and adhesive) tested with the Heat Neutral Pressure Source material under consideration; but, the test results would also be reasonably expected to vary with the particular irregular surface selected for use in the test, the pressure applied, and the size of the Heat Neutral Pressure Source tested as compared to the size of the surface irregularity. Moreover, that test itself requires "heating the non-contacting portion of the film to nearly its melting point" without specifying a standard for how close the temperature of the film must be to the film melting point during the testing steps for a valid test.

As such, we find that the scope of the claims before us is not reasonably determinable, on this record.

CONCLUSION

The decision of the examiner to reject claims 29-31, 34-36, 38-40 and 57-61 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as invention; to reject claims 29-31, 34-36, 40, 57-59 and 61 under 35 U.S.C. § 102 as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock; to reject claims 38 and 57-61 under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock, each in view of Preisler and/or Coe and/or Sadtler; to reject claim 39 under 35 U.S.C. § 103(a) as being unpatentable over the admitted state of the prior art or Peacock, each in view of Moore and/or Finke; and to reject claim 30 under 35 U.S.C. § 102 as being anticipated by Alfter, Boyd or Werstlein is reversed.

We introduce a new ground of rejection pursuant to our authority under 37 CFR 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). Therefore, claims 29-31, 34-36, 38-40 and 57-61 remain rejected.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 41.50(b)

CHUNG K. PAK)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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